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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kurt R. Marko

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EXAMINER
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BEKERMANN, MICHAEL

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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10/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/905,323

Applicant(s)

MARKO, KURT R.

Examiner

Michael Bekerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-7, 9, 10, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (U.S. Patent No. 5,926,795) in view of Herz (U.S. Patent No. 6,571,279).**

Regarding claims 1-4, and 15-18, Williams teaches the identifying of items in a current transaction, the targeting and selecting of coupons based on those items, and the printing of those coupons (Column 2, Lines 41-48). Williams further teaches printing a coupon with a border if it is a "preferred" coupon (Column 14, Lines 36-41, Figures 5A, 5B, and 7-9) and with no border if it is a "default" coupon (Column 11, Line 67 - Column 12, Line 1 and Figure 6). Williams teaches that a preferred coupon is printed when the store feels the customer will respond more favorably towards it because it has been targeted towards them (in other words, it has a higher expected value for the store) (Column 15, Line 64 - Column 16, Line 4). The borders of Williams may be any color (Column 4, Lines 11-22) or any position or orientation (Figures 5A, 5B, and 7-9). While Williams assigns an expected value (that of "preferred") to a coupon based on identified items in a transaction (Column 15, Line 64 - Column 16, Line 4), it could be

argued that Williams does not specify comparing items to a predictor set. Herz teaches a system of targeting coupons to users based on a profit maximizing strategy (Column 23, Lines 56-58) in which coupons are selected for the user by predicting which coupons will best support the vendor's marketing strategy (Column 23, Lines 56-64). The system of Herz also takes into account user purchases (Column 22, Lines 64-67) and prints the coupon (Column 24, Lines 12-14). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the current-transaction targeted coupons of Williams with the profit-maximizing coupons of Herz. This will aid in the retention of customers while simultaneously better maximizing the profit for the retailer.

Regarding claims 5, 6, 9, and 10, Williams teaches printing bordered coupons based on the dollar amount of the transaction and the number of products purchased (Column 15, Line 64 – Column 16, Line 4). Since these criteria could determine if bordered coupons are printed or not, this also signifies controlling an amount of preferred coupons printed.

Regarding claim 7, Williams teaches printing a receipt from the same printer that printed the coupons. Neither Williams nor Herz appears to specify printing the coupon on the same page as the receipt. However, common sense would dictate in this situation that it would have been obvious to one having ordinary skill in the art at the time the invention was made to not separate the receipt and the coupons when given to the customer in the hope that it would be easier for the customer to keep track of both the coupon and the receipt than if they were separated.

**Regarding claims 19 and 20**, Herz teaches the keeping track of coupon usage (Column 22, Lines 64-67 and Column 23, Line 1) and using past purchase history as well as profit-maximization to select coupons (Column 24, Lines 22-24 and Lines 34-36).

**2. ALTERNATIVELY, Claims 1-4, 7, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden (U.S. Patent No. 6,912,505) in view of Herz (U.S. Patent No. 6,571,279).**

**Regarding claims 1-4, 7, and 15-18**, Linden teaches the identifying of items in a current transaction, the targeting and selecting of coupons based on those items, and the printing of those coupons on the back of a receipt (Column 30, Lines 59-61 and Column 31, Lines 1-9). Linden does not specify a method of selecting the coupons based on expected value. Herz teaches a system of targeting coupons to users based on a profit maximizing strategy (Column 23, Lines 56-58) in which coupons are selected for the user by predicting which coupons will best support the vendor's marketing strategy (Column 23, Lines 56-64). The system of Herz also takes into account user purchases (Column 22, Lines 64-67) and prints the coupon (Column 24, Lines 12-14). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the current-transaction targeted coupons of Linden with the profit-maximizing coupons of Herz. This will aid in the retention of customers while simultaneously maximizing the profit for the retailer. By determining which coupons to print, the system inherently performs priority ranking. As the expected value changes,

the coupon appearance changes (Herz, Column 24, Lines 34-36). When the appearance of the coupon changes, the pixels that are printed on the paper are rearranged and thus, the characteristic positioning and orientation of the pixels are changed (as in a 10% coupon as opposed to a 20% coupon). A coupon having a value of 10% off, 15% off or 20% off, is considered to be multiple positioning and orientation characteristics to choose from. The orientation and positioning would be considered as a unit with the coupon (what good is a coupon without it's value).

**Regarding claims 19 and 20**, Herz teaches the keeping track of coupon usage (Column 22, Lines 64-67 and Column 23, Line 1) and using past purchase history as well as profit-maximization to select coupons (Column 24, Lines 22-24 and Lines 34-36).

**3. ALTERNATIVELY, Claims 5, 6, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden (U.S. Patent No. 6,912,505) in view of Herz (U.S. Patent No. 6,571,279), and further in view of DeLapa (U.S. Patent No. 6,076,068).**

**Regarding claims 5 and 6**, neither Linden nor Herz specify a choosing the number of coupons based on quantity of items purchased or total purchase price. DeLapa teaches printing more coupons for households with more accumulative purchases (the more items that are bought, the higher the total purchase price will be) (Column 5, Lines 18-22). It would have been obvious to one having ordinary skill in the

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art at the time the invention was made to provide more coupons to consumers who purchase more items, and thereby, the consumers get rewarded for retailer loyalty.

**Regarding claims 9 and 10**, neither Linden nor Herz specify changing the appearance of the coupons based on quantity of items purchased or total purchase price. DeLapa teaches a targeted coupon printing method in which household-specific messages may be printed with the coupons (thus changing the appearance). When the appearance of the coupon changes, the pixels that are printed on the paper are rearranged and thus, the characteristic positioning and orientation of the pixels are changed. The messages are determined according to household characteristics, and those household characteristics include accumulative purchases (the more items that are bought, the higher the total purchase price will be) (Column 5, Lines 18-22 and Column 13, Lines 42-53). It is unclear whether DeLapa intends for the message to be printed on the coupon, or on a separate page enclosed in the coupon packaging, however it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the message on the coupon itself in the interest of saving paper.

### ***Response to Arguments***

Examiner still feels that the original combination of Linden and Herz reads over the claims of the application. The amendments to the independent claims (namely specifying a set of characteristics and relating them to the coupon as a unit) do not appear to distinguish the invention over the prior art. However, upon further search,

Examiner has found what he feels to be a more appropriate reference (Williams), and it has been applied above in an additional rejection. All language in the rejections that was not present in previous actions has been underlined for Applicant's convenience.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone



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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MB

Jeffrey D. Carlson  
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